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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|-----------------------|------------------|
| 10/518,597 | 12/21/2004 | Gerard Laslaz | 22131-00015-US | 2632 |
| 30678 | 7590 | 12/06/2006 | EXAMINER | |
| CONNOLLY BOVE LODGE & HUTZ LLP | | | MORILLO, JANELL COMBS | |
| P.O. BOX 2207 | | | | |
| WILMINGTON, DE 19899-2207 | | | ART UNIT | PAPER NUMBER |
| | | | 1742 | |

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/518,597 | LASLAZ ET AL. | |
| | Examiner | Art Unit | |
| | Janelle Combs-Morillo | 1742 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 December 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>122104</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2690927 (FR'927).

FR'927 teaches an aluminum casting part with increased creep resistance (abstract) formed from aluminum alloy with 4-23% Si, 0.1-1% Mg, 0.3-4.5% Cu (which overlaps the Cu ranges in cl. 1, 4, 15, 16), preferably selected from AA356, AA319, AA413, AA392 (and wherein AA356 overlaps or touches the boundary of the presently claimed ranges of Si, Mg, Cu, Ti, Fe, Mn, Zn, and Ni of claims 1, 2, 3, 5, 7, 9-11, 14, 17-19). FR'927 further teaches the addition of 0.1-0.2 Zr increases the hot creep resistance of the alloy without harming its ductility (abstract). Because FR'927 teaches an overlapping alloy composition, it is held that FR'927 has created a *prima facie* case of obviousness of the presently claimed invention.

Overlapping ranges have been held to be a *prima facie* case of obviousness, see MPEP § 2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility.

Additionally, "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage

ranges is the optimum combination of percentages," In re Peterson, 65 USPQ2d at 1379 (CAFC 2003).

Concerning dependent claims 2, 3, 5, 7, 9-11, 14, 17-19, as stated above, AA356 overlaps or touches the boundary of the presently claimed ranges of Si, Mg, Cu, Ti, Fe, Mn, Zn, and Ni.

Concerning dependent claims 4, 15, 16, as stated above, FR'927 teaches an overlapping range of Cu.

Concerning the equation in claims 6 and 20, FR'927 teaches ranges of Mg and Cu that meet said limitation.

Concerning product by process claim 12, FR'927 does not mention (in the translated parts) the heat treatment temper applied to said Al-Si alloy. However, it would have been obvious to one of ordinary skill in the art to apply a peak strength T6 type temper to the alloy taught by FR'927 because said alloy is used for high strength cylinder heads and cylinders (abstract).

Concerning product claim 13, as stated above, FR'927 teaches said alloy is used for high strength cylinder heads and cylinders (abstract).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

R
ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

JCM
JM
November 30, 2006